

# **REMARKS**

Applicant's counsel thanks the Examiner for his continued thorough examination of the present application.

Claims 1-22 and 44-47 have been amended to more clearly describe the invention. Claims 23-43 and 48 have been canceled without prejudice. New claims 49 and 50 have been added, basis for which can be found in claims 23 and 30 as filed. It is noted that preamble text in independent claims 1 and 2 has been moved to the body of the claim, necessitating cancellation of similar preamble text from the dependent claims for consistency. The rearrangement of this text was done for clarity and does not itself vary the scope of any claims.

In the last Office action, the Examiner rejected the claims under 35 USC § 112, first paragraph based on the addition to the claims, in the last-filed Amendment, of various numerical range limitations. Where appropriate, these previously added range limitations have either been canceled, or restored to their original, as-filed values, and thus the Section 112, first paragraph rejections are overcome.

The Examiner also rejected the claims under 35 USC § 112, second paragraph for inconsistent use of the transitional phrases "comprising" and "consisting essentially of." The claims have now been amended to overcome this rejection.

The Examiner has maintained his rejection of claim 1 as being allegedly anticipated by Kubota (JP 56-095479) under 35 USC § 102(b). It is the Examiner's position that Kubota's composition "meets all the physical limitations required by

[claim 1] and therefore would inherently be capable of meeting applicant's intended use;" i.e. self-brazing. See Office action, ¶ 14. Respectfully, this inherency argument appears to treat claim 1 as a product claim in that the Examiner argues Kubota's product inherently possesses properties of the alloy described in claim 1. However, claim 1 is a method claim, which recites positive method steps. To sustain an anticipation rejection of a method claim, the Examiner must show that each and every method step is disclosed in the prior art, otherwise the rejection cannot stand. Method claim 1 has now been amended to clearly and positively recite the following brazing step: "...brazing said self-brazing alloy to a metal surface at elevated temperature."

The Examiner has recognized that Kubota does not disclose any such brazing step: "...it is noted that Kubota may not intend for his composites to be brazed...." Office action, ¶ 14. Therefore, a clear and unambiguous brazing step now being positively recited in claim 1, the rejection of this claim based on Kubota is overcome.

Claim 1 also has been rejected under 35 USC § 103(a) over Forand. Again, the Examiner notes in the Office action that "Forand may not intend for his composites to be brazed...." Office action, ¶ 17. Therefore, this rejection is overcome by the brazing step now positively recited in claim 1.

It is noted that the brazing step limitation now incorporated into claim 1 was previously presented as dependent (now canceled) claim 43, and therefore has already been searched and examined for patentability. It is therefore respectfully submitted that the incorporation of this limitation into claim 1 does not present any

new combination requiring a further search.

Accordingly, it is respectfully submitted that all rejections of claim 1 have now been overcome, and that this claim is now in condition for allowance.

The rejection of claim 2 as being allegedly anticipated by Miller or Heronemus also has been maintained on a similar basis as claim 1 *supra*. Specifically, the Examiner's position is that the "compositions of the composites [of claim 2] meet the physical limitations required by the claims and therefore would inherently be capable of meeting applicant's intended use;" i.e. self-brazing alloy. See Office action, ¶ 12. Respectfully, claim 2, like claim 1, is a method claim and also has been amended to clearly and positively recite a brazing step: "...and brazing said self-brazing alloy to a metal surface at elevated temperature."

The Examiner has recognized that neither Miller nor Heronemus discloses any such brazing step: "...It is noted that Miller or Heronemus may not intend for his composites to be brazed..." Office action, ¶ 12. Therefore, a clear and unambiguous brazing step now being positively recited in claim 2, the rejection of this claim is overcome.

It is noted that the brazing step limitation now incorporated into claim 2 was previously presented as dependent (now canceled) claim 43, and therefore has already been searched and examined for patentability. It is therefore respectfully submitted that the incorporation of this limitation into claim 2 does not present any new combination requiring a further search.

Accordingly, in view of all of the above, it is respectfully submitted that the rejections of claims 1 and 2 herein have been overcome, and that these claims are

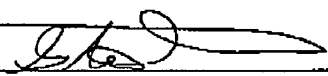
now in condition for allowance. Further, the amendments to these claims do not present any new subcombinations requiring further consideration or search because the resulting subcombinations were already present in the application, and consequently already have been searched and examined for patentability. All remaining claims in the application are dependent either from claim 1 or claim 2.

Therefore, the rejections of claims 1 and 2 now being overcome, there being no additional subcombinations requiring further consideration or search, and all remaining claims being dependent claims, it is respectfully requested this Amendment be entered in the present application, and that the application be passed for allowance.

Should the Examiner have any questions regarding the instant submission, or for any other reason which may expedite prosecution hereof, the Examiner is invited to please contact the undersigned attorney at the phone number listed below.

If there are any fees required by this communication, please charge any such fees to our Deposit Account 16-0820, Order No. 33539US1.

Respectfully submitted,  
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Date: January 5, 2004